

Application No. 09/675,525  
Amendment dated February 24, 2005  
Amendment under 37 CFR 1.116 Expedited Procedure Examining Group

### **REMARKS/ARGUMENTS**

#### **1. Telephone Interview Summary**

Applicants thank the Examiner for granting a telephone interview with the undersigned on December 17, 2004 at which the outstanding office action was discussed. Applicants agreed to incorporate the element from dependent claim 34 into independent claims as suggested by the Examiner to moot the art-based rejections. The Examiner said that so far the claims had been examined only for the bacteriophage embodiment, and additional consideration may be needed for generic claims to replicable genetic packages. Regarding the indefiniteness rejection, the Examiner expressed a preliminary view that further amendment of the claim would not be necessary but reserved the right for further consideration of this issue.

#### **2. Claim Amendments**

In accordance with the interview, applicants have amended independent claims 1 and 127 to include the element from previous claim 34. Claim 34 has been cancelled. All remaining claims have been amended to recite bacteriophage instead of replicable genetic package. Claims rendered redundant by this amendment have been cancelled. Dependency of claims depending from cancelled claims has been changed. Claim 107 (currently withdrawn) has been amended to include the definition of bacteriophage from claim 1. Dependency of claim 46 has been corrected. Dependency of claims 40 and 42 and 44 has also been changed. Several withdrawn claims have been cancelled. No amendment should be construed as an acquiescence in any ground of rejection.

#### **3. Current Status of Claims**

Claims 1, 4-9, 11-12, 22-33, 35-38, 40, 42, 44-47, 49-50, 54, 127 are pending and examined. Claims 10, 13-21, 43, 48, 51-53, 107-121 are withdrawn. Claims 2-3, 34, 39, 41, 55-106 are cancelled.

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4. Claim Rejection under 35 USC 112, second paragraph

The claims stand rejected on the basis that the phrase "heterologous nucleic acid tag that can be decoded to identify a characteristic of the compound" is unclear as to what is meant by decoding the heterologous tag and the particular structural/functional relationship between the tag and the compound. The Examiner indicates at p. 10 of the office action that incorporating the element of claim 34 into the independent claims may be remedial. The Examiner also indicated at the interview that no amendment may in fact be required. Insofar as the rejection is maintained, it is respectfully traversed.

That the claims do not define a specific relationship between a code and property of the compound is not a basis for indefiniteness. The specification (e.g., paragraph bridging pp. 25-26 indicates) that a tag can code a broad range of properties of the compound. For example, the code may designate a value, symbol, synthesis step or identity of the compound. The specification also teaches that any code can be associated with a compound via a correspondence regime (see, e.g., p. 39). Breadth of the claims is not to be equated with indefiniteness. *In re* Miller, 169 USPQ 597 (CCPA 1971).

No reason has been provided that a skilled person would have difficulty determining what was and was not included in the claims. For example, the Examiner has apparently had no difficulty in applying art. Moreover, the skilled person in the chemical arts is well familiar with the concept of tagging to label compounds (see the discussion of the art cited at p. 21 of the specification), and would have no difficulty understanding the present claims. If the claims, read in light of the specification reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute demands no more. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 225 USPQ 634 (Fed. Cir. 1985).

Given the familiarity of the artisan with the concept of tagging compound libraries, the broad teaching of the specification regarding possible relationships between tags and properties of compounds, and that breadth does not provide a basis for indefiniteness, it is respectfully submitted that the rejection should be withdrawn.

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Dependency of claims 40 and 42-44 was in error as noted by the Examiner, and has been corrected.

5. Art-Based Rejections and Double Patenting

The Examiner has indicated that all rejections would be withdrawn if the element of claim 34 was incorporated into claims 1, 46 and 127. Applicants have incorporated the element of claim 34 into claims 1 and 127 and amended claim 46 to depend from claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

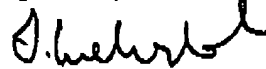
6. Reinstatement of withdrawn claims

Should claim 1 be found allowable, it is requested that withdrawn dependent claims 10, 13-21, 43, 48, 51-53 which depend from claim 1 be reinstated under MPEP 809.02(c), and also allowed. The claims are allowable for at least the same reasons as claim 1.

Applicants also request entry and rejoinder of withdrawn method claims 107-121 in accordance with MPEP § 821.04 and the TC1600 Restriction Practice Action Plan. During prosecution of this application, product and method of screening claims were restricted into different groups (*see* office action dated January 16, 2003). Applicants elected to prosecute the product claim. Method claims 107 to 121 (as amended) incorporate all the same elements as claim 1 and should be allowable for the same reasons.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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